

REMARKS

The Examiner has maintained the rejection of claims 24, 25 and 39 under 35 U.S.C. § 102 as being anticipated by Phillips et al. '595. This rejection is respectfully traversed for the following reasons.

Both independent claims 24 and 39 recite in pertinent part, “a first radiation-conductive element arranged substantially *in parallel* with a grounding substrate ... [and] a second radiation-conductive element arranged substantially *in vertical* to the grounding substrate ...” (emphasis added). In order to satisfy the relative positional limitations of the claimed radiation-conductive elements (i.e., parallel v. vertical), the Examiner has *again* broadly interpreted element 42 of Phillips as the claimed first radiation-conductive element and reads element 26 or 28 as the claimed second radiation-conductive element. The Examiner’s basis for doing so is detailed on page 3 of the outstanding Office Action under the section “Response to Arguments.” Specifically, the Examiner alleges that “such high Q circuits are routinely placed within the radiating structure of antennas and cannot necessarily be excluded from providing a radiation-conductive element because they are part of the circuitry.”

It is respectfully submitted that the Examiner’s reasoning is flawed. Indeed, according to the Examiner’s rationale, any element forming part of the circuitry of an antenna could be construed as emitting radio waves. This is clearly improper (e.g., ground 30 of Phillips forms part of the antenna circuitry but does not emit radio waves). Simply because the high Q circuit 42 of Phillips forms part of the circuitry for a radiation-conductive element does not suggest that the high Q circuit *itself* can emit radio waves, let alone evidence that such radio wave emission from the high Q circuit 42 is inherent as would be required to maintain the current rejection under § 102. In this regard, as

is well known in patent prosecution, "inherency may not be established by probabilities or possibilities," *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

Alternatively, the Examiner *newly* proposes interpreting the respective elements 26 and 28 as the claimed radiation-conductive elements (*see* top of page 3 of the outstanding Office Action). As a preliminary matter, it is respectfully submitted that this new interpretation is tantamount to a new ground of rejection, whereby Applicants should be given the right to have all means for response available when responding to a new Examiner interpretation of the cited prior art. Accordingly, it is respectfully requested that the finality of the pending Office Action be withdrawn.

Nonetheless, as previously suggested, elements 26 and 28 of Phillips are not positioned in the claimed arrangement. That is, both elements 26 and 28 are arranged vertical to the ground 30, but neither is positioned substantially in parallel thereto (one exemplary embodiment of a radiation-conductive element 42 substantially in parallel with a grounding substrate 41 is shown in Figure 35 of Applicants' drawings). Indeed, the Examiner alleges that "each *vertical* radiating element 26 and 28 may be deemed the radiation-conductive elements claimed ..." (emphasis added), evidencing the Examiner's apparent oversight that one of the claimed radiation-conductive elements is recited as being substantially in parallel with the grounding substrate.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Phillips does not anticipate claims 24 and 39.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained


in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 24 is patentable for the reasons set forth above, it is respectfully submitted that claim 25 dependent thereon is also patentable. In addition, it is respectfully submitted that claim 25 is patentable based on its own merits by adding novel and non-obvious features to the combination. Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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